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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/761,340      | 01/16/2001  | Neil E. Morrow       | KMOR116839          | 5973             |

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EXAMINER

KAVANAUGH, JOHN T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3728

DATE MAILED: 10/07/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/761,340

Applicant(s)

MORROW ET AL.

Examiner

Ted Kavanaugh

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 57-83 and 97-102 is/are pending in the application.
- 4a) Of the above claim(s) 62-64, 66, 67, 70, 71 and 73-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 57-61, 65, 68, 69, 72 and 97-102 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 62-64,66,67,70-71,73-83 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

***Claim Rejections - 35 USC § 112***

2. Claims 58,59,68,97,98,99-102 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "unrestrained" used in claims 99,100, and 101 is unclear, inaccurate and indefinite. The cable or the cable portion as claimed is under tension and therefore is not unrestrained at any portion of the cable.

In claim 97, the phrase "a forward lean system having a single general area on the boot that attached to medial and lateral cable portions coming from respective rear upper opposite sides of the boot, said single general area located at a lower front location on the boot" is unclear and indefinite. The "forward leans system" consist of the cable, cable portions, tension adjustment member, etc. However, this phrase implies that cable portions are not part of the forward lean system inasmuch as it says the system is "attached to medial and lateral cable portions". Also, it is not clear if applicant is claiming the cable portions or if these elements are only functionally recited.

Claim 68 is unclear and indefinite. It is not clear what "first and second locations" of the front portion "are substantially adjacent each other". What locations is applicant referring to?

Claims 58 and 59 are unclear and indefinite. Claim 58 has the "medial and lateral side cables attached to...a single side of the boot" and claim 59 further limits the "single side" to be "a medial side". It is not clear how the "lateral side cable" is on the medial side of the boot. It would appear that when the cable (a single continuous cable) extends over on the medial side of the foot it would now be the medial side cable. Claim 97 is similarly indefinite.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 57,58,60,61,65,68,69,72,97,98,102 rejected under 35 U.S.C. 102(b) as being anticipated by US 5060403 (Battistella).

Battistella teaches several embodiments of a ski boot having structure substantially as claimed including a forward lean system (see figure 1 which shows the front and rear quarters (3,4) in a forward lean position relative to the shell 2) comprising medial and lateral side cables (cable) causing forward flexing of the boot (see col. 4, lines 27-31 and col. 4, lines 64-68. The cables (6) of Battistella extend on both sides of

the boot and therefore would include the medial side of the boot. Battistella also teaches a tension adjustment member (5,119,219, etc). The cables (6) are all attached to the forward portion of the boot at only one at one general position (the cable extends through opening 9). Also see figure 7 which shows the cable attached to the medial side of the boot about guide 207 of the shell.

Regarding claim 72, the opening 9 of Battistella serves as the "loop back".

Regarding claims 97 and 98, the opening 9 of Battistella is located at either the lateral and medial side of the boot, as claimed, see figures 2 and 4 which show the opening 9 on one side of the boot.

Regarding claim 102, the "only single general position" would be the instep area of the boot as best shown in figures 2 and 4.

All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the

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functional limitations of a claim. See In re Mott, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

5. Claims 57,58,59,65,68,69 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4360979 (Spademan).

Spademan teaches a ski boot having structure substantially as claimed including causing forward flexing of the boot (see col. 5, lines 42-49). Spademan also teaches a tension adjustment member (buckle). The cables are all attached at only one general position of the forward portion of the boot. Also see figure 1 which shows the cable attached to the medial side of the boot about the buckle. The cable extends on both side of the boot. A marked-up copy of Spademan has been attached to this office action.

All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the

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claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See In re Mott, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

6. Claims 99-101 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4969278 (Ottieri).

Ottieri teaches a ski boot having structure substantially as claimed, see the marked up copies of figure 1 and 2 attached.

The preamble limitation of a "snowboard boot" (claim 99), a "step-in snowboard boot" (claims 100,101) is only a statement of preferred or intended use. There is no structure or any other recitation in the body of the claim that would give life, scope or meaning to the preamble recitation of these terms.

All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only

that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See In re Mott, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed. The cable or cable portions remain "**unrestrained**" when in the open position as shown in figure 3.

### ***Response to Arguments***

7. Applicant's arguments filed 9-3-02 have been fully considered but they are not persuasive.

Applicant argue that boot of Spademan is not a forward lean system.

In response, all ski boots are have the uppers leaning forward, see figure 2, and therefore are a forward lean system. Moreover, see line 3 of the abstract, which teaches about the "forward lean" of the boot.

Applicant argue that boot of Battistella is not a forward lean system.

In response, all ski boots are have the uppers leaning forward, see figure 1, and therefore are a forward lean system. See figure 1 which shows the front and rear quarters (3,4) in a forward lean position relative to the shell 2 and see col. 4, lines 27-31 and col. 4, lines 64-68.



8. Applicant's remaining arguments have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111. Moreover, "The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06" MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.**

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10. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9302 and After Finals to (703) 872-9303 (FORMAL FAXES ONLY). If the previous Fax numbers are not working use any of the following numbers (703) 305-3579 or (703) 305-3580 or (703) 305-3590. Applicants who authorize charges to a PTO deposit account may also use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached on 6AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached at (703) 308-2672.

Other helpful telephone numbers are listed for applicant's benefit.

|                                 |                     |
|---------------------------------|---------------------|
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Terminal Disclaimers

(703) 305-8408

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

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Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK  
October 3, 2002